## V. REMARKS

Entry of the Amendment is proper under 37 C.F.R. §1.116 because the Amendment: a) places the application in condition for allowance for the reasons discussed herein; b) does not raise any new issue requiring further search and/or consideration because the Amendment amplifies issues previously discussed throughout prosecution; and c) places the application in better form for appeal, should an Appeal be necessary. The Amendment is necessary and was not earlier presented because it is made in response to arguments raised in the final rejection. The amendments to the subject claims do not incorporate any new subject matter into the claims. Thus, entry of the Amendment is respectfully requested. The drawing figures are objected to under 37 CFR 1.83 (a).

Claims 13-16 are provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable claims 1-4 of copending Application No. 10/644,955. The rejection is respectfully traversed.

In determining double patenting, the issue is whether any claim of the application defines merely an obvious variation of an invention **claimed** in the earlier patent or application. It does not prohibit a later claiming of subject matter that is disclosed but not claimed in the earlier patent or application. Double patenting is concerned with attempts to "claim" related subject matter twice. In re Gibbs, 437 F.2d 486, 168 USPQ 578 (CCPA 1971). It is respectfully submitted that the rejection must be withdrawn because the claims of the instant application do not claim related subject matter twice.

The issue in addressing the judicially created doctrine of obviousness-type double patenting is whether any claim of the application defines merely an obvious variation of the invention claimed in the earlier patent applications. It is respectfully submitted that currently pending claims 13-15 do not claim an obvious variation of the invention claimed in the earlier patent applications.

The United States Patent and Trademark Office must establish a *prima facie* case of obviousness-type double-patenting or the rejection, if applied, will be reversed by the Board of Patent Appeals. The United States Patent and

Trademark Office is obligated to clearly set forth the basis of an obviousness-type double-patenting rejection. Under MPEP 804 II. B. 1., it states:

Any obviousness-type double patenting rejection should make clear:

> (A) The differences between the inventions defined in the conflicting claims--a claim in the patent compared to a claim in the application; and
>
> (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent.

It is respectfully submitted that the rejection is improper because the United States Patent and Trademark Office fails to make clear the obviousness-type double patenting rejection, particularly subparagraphs (A) and (B) above. As a result, it is respectfully submitted that the United States Patent and Trademark Office fails to establish a *prima facie* case of obviousness-type double patenting.

Withdrawal of the rejection is respectfully requested.

Claims 1-9 and 13-16 are rejected under 35 U.S.C. 102(b) as anticipated by Nishikawa (JP Publication No. 2000-300729). The rejection is respectfully traversed.

Claims 1-9 were cancelled in the Amendment filed on August 29, 2006. Thus, the rejection as applied the claims 1-9 is now moot.

Nishikawa discloses that a slot machine shields the non-winning regions such that only the winning regions are visually recognized in Figures 4 and 5. However, Nishikawa discloses a slot machine shielding each of the symbols.

On the other hand, the claimed invention discloses a gaming machine that has a shielding device for shielding not only some symbols but approximately the whole area of the variable display devices (Figures 15-18).

Withdrawal of the rejection is respectfully requested.

Newly-added claim 17 includes features not shown in the applied art.

Further, Applicants assert that there are also reasons other than those set forth above why the pending claims are patentable. Applicants hereby reserve the right to submit those other reasons and to argue for the patentability of claims not explicitly addressed herein in future papers.

In view of the foregoing, reconsideration of the application and allowance of the pending claims are respectfully requested. Should the Examiner believe anything further is desirable in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicants' representative at the telephone number listed below.

Should additional fees be necessary in connection with the filing of this paper or if a Petition for Extension of Time is required for timely acceptance of the same, the Commissioner is hereby authorized to charge Deposit Account No. 18-0013 for any such fees and Applicant(s) hereby petition for such extension of time.

Respectfully submitted,

Date: December 19, 2006

By: _____
Carl Schaukowitch
Reg. No. 29,211

**RADER, FISHMAN & GRAUER PLLC**
1233 20th Street, N.W. Suite 501
Washington, D.C. 20036
Tel: (202) 955-3750
Fax: (202) 955-3751
Customer No. 23353

Enclosure(s): Amendment Transmittal

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